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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,800	05/23/2000	David W. Cannell	05725.0572	2688

22852 7590 10/17/2002

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EXAMINER

FLOOD, MICHELE C

ART UNIT PAPER NUMBER

1654

DATE MAILED: 10/17/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/576,800

Applicant(s)
CANNELL et al.

Examiner
Michele Flood

Art Unit
1651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 8, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 24 20) ☐ Other:

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DETAILED ACTION

Acknowledgment is made of the receipt and entry of the amendment filed on August 8, 2002.

Claims 1-13 are under examination.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1 and 10-12 as amended remain rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Konishi et al. (N) and Lekim (O). The rejection stands for the reasons set forth in the previous Office action and set forth below.

Applicant argues that neither Konishi nor Lekim teach the claimed invention; however, this is not persuasive because Konishi teaches a hair tonic comprising an extract of mistletoe in an amount 0.1-5% and Lekim teaches a hair tonic comprising an extract of mistletoe in an amount as instantly claimed (see Column 2). Both Konishi and Lekim clearly teach the referenced compositions as a hair tonic. Applicant further argues that the referenced hair tonics are not clearly conveyed as compositions applied to the hair. Applicants arguments are not convincing because a hair tonic is clearly intended to be applied to the hair, and not just to the scalp or the skin. Inasmuch, Konishi and Lekim disclose that the referenced compositions are applied to the scalp, application to the scalp would also incur application to hair and/or hair roots bearing hair. Thus, the referenced compositions are clearly envisaged to be used as a hair tonic wherein the composition is applied to the hair. As the instantly claimed process is a one-step process of applying to keratinous fiber an extract of mistletoe, the claimed functional effect of protecting keratinous fiber from extrinsic damage is inherent to the method of using the compositions taught by Konishi and Lekim.

Applicant further argues that the Office has failed to provide a *prima facie* case of obviousness because neither Konishi nor Lekim provide a clear and particular evidence of a motivation and/or suggestion to apply the referenced mistletoe-containing hair tonic

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compositions to the hair. However, Applicant's arguments are not persuasive because the claims are drawn to a method of protecting keratinous fiber from extrinsic damage comprising applying to said keratinous fiber a composition comprising mistletoe extract. The cited references disclose a hair tonic comprising mistletoe extract --- which appears to be identical to the presently claimed composition and method of using thereof, since they exhibit beneficial effects to the hair, and their envisaged intended use is directed to application to hair as they are hair tonics. Therefore, the cited references are considered to anticipate the claimed method of protecting keratinous fiber from extrinsic damage comprising applying to keratinous fiber a composition comprising a mistletoe extract.

In the alternative, even if the claimed method of using the disclosed compositions are not identical to the referenced extract with regard to some unidentified characteristics, the differences between that which is disclosed and that which is claimed are considered to be so slight that the referenced extract preparation is likely to inherently possess the same characteristics of the claimed extract preparation particularly in view of the similar characteristics which they have been shown to share. Thus, the claimed method of using the disclosed compositions would have been obvious to those of ordinary skill in the art within the meaning of USC 103.

The United States Patent and Trademark Office is not equipped to conduct experimentation in order to determine whether or not Applicants' method of using the claim designated plant extract composition differs and, if so, to what extent, from that discussed in the

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references. Therefore, with the showing of the references, the burden of establishing non-obviousness by objective evidence is still shifted to Applicants.

Accordingly, the claimed invention as a whole was at least *prima facie* obvious, if not anticipated by the references, especially in the absence of sufficient, clear, and convincing evidence to the contrary.

Claims 1-8 and 10-13 as amended remain rejected under 35 U.S.C. 103(a) as being unpatentable over Konishi et al. (N) and Lekim (O) in view of Pineau et al. (A). The rejection stands for the reasons set forth in the previous office action and set forth below.

Applicant's arguments have been fully considered but they are not deemed persuasive because the cited references provide the suggestions and motivation to the claimed invention.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary references of Konishi and Lekim were relied upon for the reasons set forth above. Because neither Konishi nor Lekim teach a method of using a composition further comprising at least one sugar the secondary reference of Pineau was relied upon because Pineau

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teaches a composition comprising heterogenous polyholosides comprising 2 to 10 oses or monosaccharides. Pineau teaches the sugar containing compositions as active agents to combat extrinsic aging of the skin and hair. See Column 3, lines 43-67 to Column 4, lines 1-64.

Thus, with Lekim and Konishi providing the motivation to use mistletoe extracts for the treatment and care of keratinous fibers, and with Pineau suggesting that the sugar-containing polyholosides according to his invention are beneficial in protecting keratinous fibers from extrinsic damage (see Column 4, lines 59-64), it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the instantly claimed old and well-known ingredients to provide a composition for the protection of keratinous fibers from extrinsic damage since each of the claimed ingredients were each known for the same beneficial effect. Moreover, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the instant ingredients for their known benefit since each is well known in the art for their claimed purpose for the treatment and protection of keratinous tissue from extrinsic damage. This rejection is based on the well established proposition of patent law that no invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients, *In re Sussman*, 1943 C.D. 518. Applicants invention is predicated on an unexpected result, which typically involves synergism, an unpredictable phenomenon, highly dependent upon specific proportions and/or amounts of particular ingredients. Any mixture of the components embraced by the claims which does not exhibit an unexpected result (e.g., synergism) is therefore *ipso facto* unpatentable.

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Accordingly, the instant claims, in the range of proportions where no unexpected results are observed, would have been obvious to one of ordinary skill having the above cited references before him.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, especially in the absence of evidence to the contrary.

Accordingly, the claimed invention was prima facie obvious to one of ordinary skill in the art at the time the invention was made, especially in the absence of evidence to the contrary.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-13 as amended remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 09/527,599. The rejection stands for the reasons set forth in the

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previous Office action and repeated below, as Applicant traverses the rejection without setting forth any substantial reasons for the traversal of the rejection.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are drawn to the use of identical or at least very similar ingredients to effect the same result or essentially the same result. Thus, the claims are obvious variants of each other.

No claims are allowed.

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Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Flood whose telephone number is (703) 308-9432. The examiner can normally be reached on Monday through Friday from 7:15 am to 3:45 pm. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196 or the Supervisory Patent Examiner, Michael Wityshyn whose telephone number is (703) 308-4743.

MCF

October 15, 2002



CHRISTOPHER R. TATE
PRIMARY EXAMINER